



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/729,959

12/09/2003

Osamu Tachizawa

246310US0

2738

22850

7590

05/15/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

05/15/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/729,959	Applicant(s) TACHIZAWA ET AL.	
	Examiner Lakshmi S. Channavajjala	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of response dated 2-17-09 is acknowledged.

Claims 1-20 are pending in the instant application.

Claim Rejections - 35 USC § 102

1. Claims 1-3, 5-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Flick, Ernest (Cosmetics and Toiletry Formulations, submitted on PTO-1449 dated 8-13-08) as evidenced by Orion Chemique (**should read “as evidenced by the translation of the Brief submitted to European Patent Office by Cognis Gmbh”**).

Flick teaches clear liquid conditioning shampoos and pearlescent shampoos comprising Standapol ES-1, which is sodium laureth sulfate. The translation of a Brief submitted to European Patent Office by Cognis Gmbh describes that ES-1 is made of C12-C14 fatty alcohols with a homolog distribution of ethoxylation of n=0 is 35.43%, n=1 is 21.88, n= 2 is 15.49 and the remaining proportions up to 100% wt are formed by fatty alcohol ether sulfate with 3 or more parts of ethylene oxide. Thus, the percentage distribution of different ethoxylated sulfates fall within the ranges in claims 1 and 6-9. For the amounts of the sulfate, the compositions of Flick describe 30% and 10%, which is within the claimed amounts of claims 1, 10 and 11. For the claim 3 cationic polymers, the clear liquid conditioning shampoo on page 598 of Flick shows 2% polyquart H, a PEG-15 tallow polyamine, which is a cationic conditioning polymer see US 4,314,807 (see col. 22, shampoo formulation) and is within the range of claim 16. For claims

Art Unit: 1611

2, 12 and 13, Flick teaches cocoamide DEA and Laureth-9 and for the claimed amphoteric surfactants, Flick teaches betaines such as cocamidopropyl betaine, all of which are also described in the instant specification. For the claimed pearlescent agents (5 and 18), Flick teaches glycol stearate and glycolo distearate in the compositions of page 542 shampoo composition, which also contains the above components i.e., ES-1, nonionic and amphoteric surfactants. Hence Flick anticipates instant claims.

Claim Rejections - 35 USC § 103

2. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flick **as evidenced by the translation of the Brief submitted to European Patent Office by Cognis GmbH** as applied to claims 1-3, 5-16 and 18-20 above, and further in view of US 5,714,446 to Bartz.

Flick does not teach silicones in the composition. Bartz teaches hair conditioning shampoo compositions comprising ethoxylated sulfate surfactants and a nonionic silicone conditioning agent (see claims, abstract and examples). The silicone conditioning agent in the composition of '446 is in the same amount as that claimed in the instant application. '446 suggests 0.1% to 10% of silicone (col. 10, l 1-5), which is within the claimed range. It would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to employ the silicone conditioning agent of '446 in the composition of Flick because '446 teaches that silicones are essential to improve the hair conditioning

Art Unit: 1611

(col. 9, L 50-60) and suggests that the combination of the surfactant, silicone conditioner and a cationic conditioning polymer provides excellent cleaning and also hair conditioning benefit.

5. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flick.

Flick fails to teach the claimed pH ranges. Instant claims recite a pH after dilution of the composition by 20 times. Flick teaches adjusting pH of the composition to 6.5 +/- 0.5 or 5.5-6.5 (pages 598 and 642) and hence the burden is on applicants to show that the pH of the compositions of Flick, which recite the claimed ingredients, do not possess the claimed pH 6 for claim 19, after diluting it 20 times. Even though Flick fails to teach the pH of 3.5 to 4.5, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to optimize the pH of the compositions of Flick such that the compositions are suitable for use as hair conditioning shampoos.

Response to Arguments

Applicants inquired regarding the citation of Orion Chemique in the rejection: Claims 1-3, 5-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Flick, Ernest (Cosmetics and Toiletry Formulations, submitted on PTO-1449 dated 8-13-08) as evidenced by Orion Chemique.

Art Unit: 1611

In response to the inquiry, it is noted that the previous office action inadvertently stated "as evidenced by Orion Chemique" in the preamble of the rejection, when in fact Orion Chemique has not been used as evidence in the rejection. The examiner intended to state "as evidenced by the translation of Brief submitted to EPO by Cognis GmbH", which is clear from the body of the rejection. The very first lines on page 3 of the action dated 10-15-08 state that the translation submitted to EPO by Cognis GmbH for the description of ES-1 has been used as evidence. Furthermore, the body of the rejection does not refer to Orion Chemique for any support thus showing that the examiner did not rely on the rejection. Hence, the finality of the instant rejection is deemed proper.

6. Applicant's arguments filed 2-17-09 have been considered but not found persuasive.

Applicants argue that the evidence produced by Cognis in the opposition notes that Standapol ES-1 was produced by Henkel KGaA (now Cognis GmbH) and that the Declaration by Mr. Hans-Peter Mueller only states that the manufacturing method for producing Standapol ES-1 has not been changed since January 1997 to February 29, 2008. It is argued that at best Mr. Mueller's declaration could attest to the composition of Standapol ES-1 from January 1, 1997 until February 29, 2008, but provides no relevant evidence as to the composition of Standapol ES-1 prior to January 1, 1997. Applicants argue that Flick was copyrighted in 1989 and there is no evidence as to the composition of Standapol ES-1 as of 1989. It is argued that since there is no evidence as to the composition of Standapol ES-1 as of 1989 and hence the claimed invention is clearly not anticipated nor rendered obvious from this reference. Applicants argue that the

Art Unit: 1611

references of Flick and Bartz do not teach the ethoxylation distribution of the instant claims.

Applicants' arguments are not persuasive because the arguments are not supported by any evidence. It is clear from the evidence that as of January 1997 (which is before applicants' priority date); Standapol ES-1 has the ethoxylation distribution that reads on the claimed sulfate surfactant. While it is true that the formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark, Applicants have not shown any evidence that the Standapol ES-1 of Flick is different from Standapol ES-1 of Cognis (1997). The arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Further, the examiner has no access to laboratory facilities to test the composition and hence burden is put on the applicant to prove that the Standapol ES-1 of 1997 and that of 1989 are different. *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Since both Flick and Cognis GmbH (1997) refer to the same trademark product Standapol ES-1 and since applicants have not provided any evidence to show the trademark product of 1989 is different from that of 1997, the examiner maintains the argument that the product of Flick is the same as that of 1997 product of Cognis GmbH and reads on the instant claimed product.

The argument that the deficiencies are not cured by Bartz, which has merely been cited for a disclosure of a nonionic silicone conditioning agent, are not persuasive because

Art Unit: 1611

Bartz has not been cited for ES-1 or the claimed surfactant and instead only for nonionic silicone conditioning agent.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner,
Art Unit 1611
May 6, 2009